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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte L. MARK ERNEST, CHRISTOPHER FINDEN-BROWNE,
and JAMES R. MOORE

Appeal 2009-007263
Application 10/005,862
Technology Center 3600

Decided: January 21, 2010

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-16 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed a system for managing IT infrastructure in which transaction data is identified by the agents of the various components and reported to a central collection location. The raw data permits a determination of the business value generated by each component (Spec. 2-3). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A computerized process for managing an integrated information technology (IT) system having a plurality of components and providing a plurality of services, the process comprising the steps of:

collecting, at each of the components, usage data indicating an amount of use each component receives in providing each of the services,

reporting the usage data of each component for each service;
constructing a valuation function for valuing each service,
correlating each service with each component used to provide said service; and

determining from said correlated services and components a value of each component and a value to said IT system.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Adriaans US 6,311,175 B1 Oct. 30, 2001

The following rejections are before us for review:

1. Claims 1-9¹ are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.
3. Claims 1-16 are rejected under 35 U.S.C. § 102(a) and (e) as unpatentable over Adriaans.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to the rejection of claim 1-9 under 35 U.S.C. § 101 this issue turns on whether claim 1 passes the “machine or transformation test”.

With regards to the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, this issue turns on whether those skilled in the art would understand what is being claimed when the claim is read in light of the specification.

¹ We note that the Examiner has withdrawn the rejection of claims 10-16 under 35 U.S.C. § 101 as directed to non-statutory subject matter (Ans. 14).

With regards to claims 1-16 this issue turns on whether Adriaans discloses the cited claimed limitations which have been argued by the Appellants.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Adriaans discloses a system for generating performance models of complex information systems (Title). System components are subject to periodic monitoring associated with performance thresholds. Resulting data is accumulated and data mined for component and functional relationships within the IT system (Abstract).

FF2. Adriaans discloses that data monitors 310 may be placed throughout the IT infrastructure 100/305 at various components within the system. The data is stored in a historical database 315 and can be usage information at a component level (e.g. hardisk, database, server). For instance, a monitor may record data on a harddisk to record free capacity and whether the disk is accessed or not. Similar data collected from the database may include the number of users, query volume, and access time. (Col. 8:23-43).

FF3. Adriaans at Col. 6:56-65 discloses service level agreements (SLA's) which are a numerical threshold used to evaluate a particular performance level of any number of system components or elements. The SLA's convert

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

data that is monitored into Boolean values indicating whether the SLA threshold is met or not.

FF4. Adriaans at Col. 10:39-52 discloses that a numerical value is determined following the success percentage at which state data was recorded over a given time period for the target SLA.

FF5. Adrianns at Col. 3:30-46 and 54-60, Col. 4:30-40, Col. 5:14-40, Col. 6:15-35, Col. 8:15-40, Col. 9:15-37, Col. 10:14-28 and Col. 11:30-64 does not disclose a table identifying the components used in providing each service or fed by a change process to maintain the table as changes are made to the IT system.

PRINCIPLES OF LAW

Principles of Law Relating to 35 U.S.C. § 101

The en banc court in *Bilski* held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008). The court in *Bilski* further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” *Id.* at 959-60.

The court explained the machine-or-transformation test as follows: “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954 (citations omitted). The court explained that “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent-eligibility” and “the involvement of the machine or transformation in the claimed

process must not merely be insignificant extra-solution activity.” *Id.* at 961-62 (citations omitted).

Principles of Law Relating to 35 U.S.C. § 112, second paragraph

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

ANALYSIS

Rejections under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 101 is improper because “subject matter is being transformed” (Reply Br. 2). The Appellant also argues that the specification discloses that each agent 24 periodically reports data to the component on which it is installed (Reply Br. 4).

In contrast, the Examiner has determined that the rejection of claim 1 under 35 U.S.C. § 101 is proper (Ans. 5-6).

We agree with the Appellants. In claim 1, the claimed process is drawn to a process for collecting usage data “at each of the components” in “said IT system”. Specifically, the claim includes a limitation for “collecting, *at each of the components*, usage data” and the claim body also makes reference to “said *IT system*”. Thus, the process is tied to the IT system’s *components* which is a “particular machine or apparatus” meeting the machine-or-transformation test recited in *Bilski*. For these reasons the rejection of claim 1, and dependent claims 2-9, under 35 U.S.C. § 101 is not sustained.

Rejections under 35 U.S.C. § 112, Second Paragraph

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is improper because “the requirement that the claim be read in light of the specification will satisfy any need to understand what is occurring in the process” (Supp. Br. 9).

In contrast, the Examiner has determined that the rejection is proper because: 1) it is unclear what data is being reported, 2) it is unclear how the valuation function is constructed and specifically used, and that 3) it is unclear how values for components and the IT system is determined based on the correlations (Ans. 7). The Examiner also states that “there is no interconnectivity between the five steps recited in claim 1” and that it unclear how the invention accomplishes the intended use of the preamble (Ans. 16).

We agree with the Appellants. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *See Orthokinetics, Inc at 1576*. Here, one of ordinary skill in the art would understand what each of the five steps of claim 1 was claiming when read in light of the specification and find the five steps properly interconnected. The recited five steps also would be considered by one of ordinary skill in the art in light of the specification to “manage and IT system” to some degree. The Appellants are entitled to broadly claim the invention. For these reasons, the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is not sustained.

Rejections under 35 U.S.C. § 102

The Appellants argue that the rejection of claim 1 is improper because *Adriaans* in “no way suggests the ability to determine the value of a component, based on its role in performing a service by the IT system” (Supp. Br. 10). The Appellants argue that in *Adriaans* there is no structure that collects usage data and uses the usage data to evaluate the value of components of the system (Supp. Br. 10). The Appellants argue that the reference uses various test programs to simulate actual system transactions not usage data which can be used to determine the value of a component (Supp. Br. 11).

In contrast, the Examiner has determined that *Adriaans* discloses the cited features (Ans. 16-19).

We agree with the Examiner. *Adriaans* discloses that *data monitors 310 may be placed throughout the IT infrastructure 100/305 at various*

components within the system with data stored in a historical database 315 *that can be usage information* at a component level (FF2), so usage data is collected at a component level and reported as claimed in claim 1. Further, Adriaans discloses service level agreements (SLA's) which are a *numerical threshold* used to evaluate a particular performance level of any number of system components or elements. The SLA's convert data that is monitored into Boolean values indicating whether the SLA threshold is met or not (FF3) and therefore serves as a "valuation function" for any particular component as claimed in claim 1. Adriaans also discloses that a numerical *value* is determined following the success percentage at which state data was recorded over a given time period for the target SLA (FF4) which serves to determine a "value" for the component. The Appellants argue that Adriaans is used to "simulate" actual systems transactions but there is nothing in the claim that excludes the usage data from being "simulation data". For these reasons the rejection of claim 1-3 under 35 U.S.C. § 102 (a) and (e) as unpatentable over Adriaans is sustained. The Appellants have not provided separate arguments for claims 5-12 and 14-15 and the rejection of these claims is sustained for these same reasons.

The Appellants also argue that the reference fails to disclose constructing a relationship table identifying the components used in providing each service as recited in claims 4, 13, and 16 (Supp. Br.11). The Examiner has found that Adriaans discloses such a table at: Col. 3:30-46 and 54-60, Col. 4:30-40, Col. 5:14-40, Col. 6:15-35, Col. 8:15-40, Col. 9:15-37, Col. 10:14-28, and Col. 11:30-64 (Ans. 9-10, 12-13).

We agree with the Appellants. Adriaans at the locations cited by the Examiner does not disclose a table identifying the components used in

providing each service or fed by a change process to maintain the table as changes are made to the IT system (FF5). For these reasons the rejection of claims 4, 13, and 16 under 35 U.S.C. § 102 (a) and (e) as unpatentable over Adriaans in not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-9 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-12, and 14-15 under 35 U.S.C. § 102 (a) and (e) as unpatentable over Adriaans.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4, 13, and 16 under 35 U.S.C. § 102 (a) and (e) as unpatentable over Adriaans.

DECISION

The Examiner's rejection of claims 1-3, 5-12, and 14-15 is sustained. The Examiner's rejection of claims 4, 13, and 16 is reversed.

Appeal 2009-007263
Application 10/005,862

AFFIRMED-IN-PART

MP

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